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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE DIVISIONAL APPLICATION OF:

Shafer et al.

Grp. Art. Unit: 3747

Application No: 10/617,289

Examiner: J. Kwon

Filing Date: 07/10/03

Date: September 13, 2005

LINEAR CONTROL VALVE FOR
CONTROLLING A FUEL INJECTOR AND
ENGINE COMPRESSION RELEASE BRAKE
ACTUATOR AND ENGINE USING SAME

Atty. Dkt. No: 00-564.1

RESPONSE TO OFFICE ACTION

In response to the Office Action dated June 14, 2005, please consider the following remarks. Reconsideration of the present application is respectfully requested.

Claims 21-40 stand rejected under 35 USC §103(a) over Eisenbacher in view of Determan. Applicants respectfully disagree since there is no motivation in the cited art, and none is identified in the Office Action, to support the notion that one with ordinary skill in the art would substitute the valve of Determan in place of the multiple valves of Eisenbacher to arrive at Applicants' claimed invention. Applicants concede that their claimed invention is probably not pioneering, and is thus like most other inventions that involve a new combination of known things. And the cited references show that individual features of the claimed invention are separately known. However, apart from the fact that the Office Action is utterly silent as to why one with ordinary skill in the art would be motivated to combine the references in the way relied upon in the rejections, it does not even appear as if some of the claims were examined.

For instance, claim 28 requires that the valve member include an internal passage disposed therein. Claim 29 requires that the internal passage be fluidly connected to the low pressure reservoir. This allows the low pressure to be equalized on opposite sides of the valve member so as to avoid hydraulic forces that could develop due to leakage along the sides of the valve member from the high pressure passage(s). There should be no dispute that neither the internal passage strategy for equalizing pressure on opposite ends of the spool, nor the notion of connecting the same to low pressure is even contemplated by the cited references of record. This concept is also reflected in other ones of the claims, but again, the Office Action is utterly silent

I certify that this paper or fee was mailed with sufficient postage via first class mail on the 13th day of September, 2005 to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; Name Printed : Carrie Stremming; Signature 